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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,593	06/29/2004	Stefan Prange	0119010-00066	4731

29177 7590 02/09/2009  
BELL, BOYD & LLOYD, LLP  
P.O. BOX 1135  
CHICAGO, IL 60690

EXAMINER
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CHAMPAGNE, LUNA

ART UNIT	PAPER NUMBER
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3627

MAIL DATE	DELIVERY MODE
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02/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/500,593	PRANGE, STEFAN	
	<b>Examiner</b>	<b>Art Unit</b>	
	LUNA CHAMPAGNE	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/29/04</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicant's correspondence received on 6/29/04 is acknowledged. Claims 1-9 are cancelled. Claims 10-20 are presented for examination.

### ***Specification***

The substitute specification filed 6/29/04 has been entered.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18 and 20 are rejected as non-statutory subject matter, which is not patent eligible under 35 U.S.C. 101.

The Examiner notes that the apparatus and system of claims 18 and 20 are directed to software, per se (e.g. A mobile radio subscriber identity module), which does not fall within one of the four statutory classes of invention.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 10, 15, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Julin (WO 92/19078).

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Re claims 10, 20, Julin teaches a method for billing a call made by a user of a mobile radio terminal via the mobile radio terminal and a mobile radio network, the method comprising: determining, by the mobile radio terminal, an entry as to whether a call is to be billed as service-related or private (*see e.g. page 2, lines 23-27 – a service identity and a private identity*); sending a message representing the entry and the identity of a mobile radio subscriber identity module to the mobile radio network; and storing information on the identity and information on the service-related or private nature of the call (*see e.g. page 7, lines 24-33*).

Re claim 15, Julin teaches a method wherein the message comprises an MSISDN or IMSI concerning the mobile radio terminal user (*see e.g. page 1, lines 27-31*).

3. Claims 11-14, 16, are rejected under 35 U.S.C. 103(a) as being unpatentable over Julin (WO 92/19078), in view of Patel (5,835,856).

Re claims 11-14, 16, Julin does not explicitly teach a method, wherein the call is a current or recently made call; wherein the message is a short message; wherein the message is a USSD; wherein the message comprises identity details concerning the mobile radio terminal user; the method further comprising: detecting an entry of a user before or during or after a call.

However, Patel teaches a method, wherein the call is a current or recently made call (*see e.g. col. 5, lines 1-4*); wherein the message is a short message; wherein the

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message is a USSD (*see e.g. col. 3, lines 63-66*); wherein the message comprises identity details concerning the mobile radio terminal user ( *see e.g. col. 3, lines 10-21*); a method further comprising: detecting an entry of a user before or during or after a call (*see e.g. col. 3, lines 10-13*).

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to modify Julin and include the steps wherein the call is a current or recently made call; wherein the message is a short message; wherein the message is a USSD; wherein the message comprises identity details concerning the mobile radio terminal user; the method further comprising: detecting an entry of a user before or during or after a call, as taught by Patel, in order to

4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Julin (WO 92/19078), in view of Kelley (2002/0042715 A1).

Re claim 17, Julin does not explicitly teach a method further comprising: assigning, by a billing computer, on the mobile radio network side data representing the entry to a call and taking into account the data for splitting the invoice into private and service-related calls the next time an invoice is produced.

However, Kelley teaches a method further comprising: assigning, by a billing computer, on the mobile radio network side data representing the entry to a call (*see e.g. paragraph 0031 - pressing '1' for personal or '2' for business*); and taking into account the data for splitting the invoice into private and service-related calls the next time an

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invoice is produced (see e.g. paragraph 0006 – separate statements for the employer and for the employee).

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to modify Julin and include the steps of assigning, by a billing computer, on the mobile radio network side data representing the entry to a call and taking into account the data for splitting the invoice into private and service-related calls the next time an invoice is produced, as taught by Kelley, in order to better capture the usage of a mobile phone and reasonably allocate the charges.

5. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelley (2002/0042715 A1).

Re claim 18, Kelley teaches a Mobile radio terminal, comprising an assignable key; and an apparatus for sending, when the key is actuated, a message to a mobile radio network regarding the service-related or private nature of a call made from the mobile radio terminal (see e.g. paragraph 0031 – *the user enters one or more pre-designated keys ---e.g. pressing '1' for personal or '2' for business. These additional keys are recorded by the carrier (=Service provider) and are included in the CDRS. During the separation process calls are identified as employer or employee calls by looking up the entered key and comparing it to what the employer had specified as codes indicating either business or personal transactions*).

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Re claim 19, Kelley teach a mobile radio, wherein the key is a softkey of the mobile radio terminal (see e.g. paragraph 0031 – the user enters one or more pre-designated keys -- e.g. pressing '1' for personal or '2' for business)

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUNA CHAMPAGNE whose telephone number is (571)272-7177. The examiner can normally be reached on Monday - Friday 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Luna Champagne/  
Examiner, Art Unit 3627

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627